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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/778,034	02/17/2004	Hung Hsiang Hsu	MR2863-152	6163
4586 7590 09/12/2008 ROSENBERG, KLEIN & LEE 3458 ELLICOTT CENTER DRIVE-SUITE 101 ELLICOTT CITY, MD 21043				
EXAMINER				
WONG, BLANCHE				
ART UNIT		PAPER NUMBER		
2619				
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09/12/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/778,034

Applicant(s)

HSU, HUNG HSIANG

Examiner

Blanche Wong

Art Unit

2619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-16 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date Jan 15, 08
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Inventor's Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "local SIP agent client" (claims 1 and 2) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Specification and Fig. 2 discloses a voice process module 15 that is able to convert the analog voice signal generated by the IP phone into digital signal, p.7, lines 6-7, and that is able to convert the digital signal sent from the SIP processing module 14 into voice signal, p.7, lines 8-9. Specification does not disclose "a local SIP again client ... to convert an analog voice signal of the local device into a digital signal ... and to convert a digital signal sent from the remote SIP agent client into an analog voice signal ..." as recited in claims 1 and 2.

Claim Objections

3. Claims 1 and 2 are objected to because of the following informalities:

With regard to claim 1, Examiner suggests replacing "SIP agent client" in line 1 of the preamble with "the local SIP agent client" to differentiate it with "at least one remote

SIP agent client" in lines 3-4 of the preamble and to be in consistent with "a local SIP agent client" in line 9.

With regard to claim 1, Examiner suggests replacing "the digital signal sent from the remote SIP agent client" in lines 11-12 with "a digital signal sent from the remote SIP agent client" to differentiate it with "a digital signal" in line 10.

With regard to claim 1, Examiner suggests replacing "the voice signal" in line 13 with "the analog voice signal" in consistent with "an analog voice signal" in line 12.

With regard to claim 2, Examiner suggests replacing "SIP agent client" in line 2 of the preamble with "the local SIP agent client" to differentiate it with "at least one remote SIP agent client" in lines 4-5 of the preamble and to be in consistent with "a local SIP agent client" in line 15.

With regard to claim 2, Examiner suggests replacing "the digital signal sent from the remote SIP agent client" in lines 17-18 with "a digital signal sent from the remote SIP agent client" to differentiate it with "a digital signal" in line 16.

With regard to claim 2, Examiner suggests replacing "the voice signal" in line 19 with "the analog voice signal" in consistent with "an analog voice signal" in line 18.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 1-16** are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a voice process module 15 that is able to convert the analog voice signal generated by the IP phone into digital signal, p.7, lines 6-7, and that is able to convert the digital signal sent from the SIP processing module 14 into voice signal, p.7, lines 8-9., does not reasonably provide enablement for a local SIP again client ... to convert an analog voice signal of the local device into a digital signal ... and to convert a digital signal sent from the remote SIP agent client into an analog voice signal ..." (claims 1 and 2). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Furthermore, Specification discloses "[t]he microprocessor unit 141 mainly serves to execute SIP call server program and SIP agent client program. The memory unit 142 is electrically connected with the microprocessor unit 141. The memory unit 142 includes an ROM for storing the SIP call server and agent client program to be executed, ...", p. 7, lines 14-18. Specification does not enable "a local SIP agent client for executing at least one SIP agent client program ... and an SIP call server for executing at least one SIP call server program ..." as recited in claims 1 and 2.

Obviously, the SIP call server having a SIP structure is significant in claims 1 and 2. Specification points out "[i]n the SIP structure, at least one SIP call server must be built in addition to the user agent. The SIP call server can serve as a proxy server, redirect server, registry server, voice mail server, etc.", p.2, lines 20-22, and "in the SIP architecture, each UA must register one's own SIP URI and current IP location in the

registry server, whereby the SIP call server can identify every UA. After registered, other UA on the Internet can communicate with the UA through the SIP call server", p.2, lines 26-p.3, line 1. However, claims 1 and 2 assumes a SIP call server having a SIP structure because a SIP structure is only recited in the preamble. However, the recitation "being SIP structure" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). That is, simply qualifying the call server and agent client by using the abbreviate "SIP" does not enable claims 1 and 2.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 1-16** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claims 1 and 2, it is unclear what is "the network apparatus" in lines 1-2, or whether it is the network system.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1 and 2** are rejected under 35 U.S.C. 103(a) as being unpatentable over Osterhout et al. (U.S. Pat No. 6,965,614) in view of Laxarus et al. (US 2004/0234059) and Donovan et al. (US 6,512,818).

With regard to claim 1, Osterhout discloses

at least one local connecting port (**ports 34A and 34B in Fig. 1 and 2**) for coupling with the local devices (**USB device 38,40,42 in Fig. 1**);

a remote connecting port (**network interface 102 in SIP gateway 32 in Fig. 2**) for coupling with the network (**data network 12 in Fig. 1 or same data network 11 in Fig. 2**); and

an SIP processing module (**SIP gateway 32 in Fig. 1**) electrically connected with the local connection port (**ports 34A and 34B in Fig. 1**) and remote connecting port (**network interface 102 in SIP gateway 32 in Fig. 2**).

Lazarus discloses a local SIP agent client for executing at least one SIP client program to convert an analog voice signal into a digital signal, or convert the digital signal into an analog voice signal ("**a cable modem 36 [in communications gateway**

14] [is] used to convert the received RF signals into digital baseband signals and digital baseband signals into RF signals for transmission", para. [0007]). Donovan discloses an SIP call server ("**system of Fig. 5 employs SIP**", col. 7, line 55) for executing at least one SIP call server program ("**SIP defines six types of requests**", col. 7, line 63), whereby after the local SIP agent client and the remote SIP agent client perform SIP registry and the locations of the local SIP agent client and the remote SIP agent client are linked ("**REGISTER provides information about a user's location to a SIP server**", col. 8, lines 8-10), the local SIP agent client and the remote SIP agent client can bidirectionally telecommunicate with each other by voice ("**... establish a call between a call originator 101 and a call terminator 103**", col. 8, lines 13-14).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine a local SIP agent client for executing at least one SIP client program to convert an analog voice signal into a digital signal, or convert the digital signal into an analog voice signal, and an SIP call server for executing at least one SIP call server program, whereby after the local SIP agent client and the remote SIP agent client perform SIP registry and the locations of the local SIP agent client and the remote SIP agent client are linked, the local SIP agent client and the remote SIP agent client can bidirectionally telecommunicate with each other by voice as taught in Lazarous and Donovan in Osterhout's SIP gateway to provide for client-server as necessitated in SIP processing and to obtain the invention as specified in claim 1.

With regard to claim 2, Osterhout discloses

a network device (**SIP gateway 32 in Fig. 1**) having at least one local connecting port (**ports 34A and 34B in Fig. 1 and 2**) for coupling with the local devices (**USB device 38,40,42 in Fig. 1**);

a network device (**SIP gateway 32 in Fig. 1**) having a remote connecting port (**network interface 102 in SIP gateway 32 in Fig. 2**) for coupling with the network (**data network 12 in Fig. 1 or same data network 11 in Fig. 2**); and

an SIP processing module (**SIP gateway 32 in Fig. 1**) electrically connected with the local connection port (**ports 34A and 34B in Fig. 1**) and remote connecting port (**network interface 102 in SIP gateway 32 in Fig. 2**).

Lazarus discloses a network device being a cable modem (**a cable modem, para. [0001]**) and a local SIP agent client for executing at least one SIP client program to convert an analog voice signal into a digital signal, or convert the digital signal into an analog voice signal (**"a cable modem 36 [in communications gateway 14] [is] used to convert the received RF signals into digital baseband signals and digital baseband signals into RF signals for transmission", para. [0007]**). Donovan discloses an SIP call server (**"system of Fig. 5 employs SIP", col. 7, line 55**) for executing at least one SIP call server program (**"SIP defines six types of requests", col. 7, line 63**), whereby after the local SIP agent client and the remote SIP agent client perform SIP registry and the locations of the local SIP agent client and the remote SIP agent client are linked (**"REGISTER provides information about a user's location to**

a SIP server", col. 8, lines 8-10), the local SIP agent client and the remote SIP agent client can bidirectionally telecommunicate with each other by voice ("**... establish a call between a call originator 101 and a call terminator 103", col. 8, lines 13-14)**).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Lazarous and Donovan with Osterhout in order to provide for a cable modem, a local SIP agent client for executing at least one SIP client program to convert an analog voice signal into a digital signal, or convert the digital signal into an analog voice signal, and an SIP call server for executing at least one SIP call server program, whereby after the local SIP agent client and the remote SIP agent client perform SIP registry and the locations of the local SIP agent client and the remote SIP agent client are linked, the local SIP agent client and the remote SIP agent client can bidirectionally telecommunicate with each other by voice in a SIP gateway to obtain the invention as specified in claim 2.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blanche Wong whose telephone number is 571-272-3177. The examiner can normally be reached on Monday through Friday, 830am to 530pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edan Orgad can be reached on 571-272-7884. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2619

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Blanche Wong/
Examiner, Art Unit 2619
September 5, 2008

/Edan Orgad/
Supervisory Patent Examiner, Art Unit 2619